

REMARKS

Applicants have carefully reviewed the Office Action mailed November 2, 2005, prior to preparing this response. Currently claims 21-31 are pending in the application, wherein claims 21-31 have been rejected by the Examiner. New claims 32-35 have been added with this paper. Support for these claims may be found, for example, at page 13, lines 13-20. Thus, no new matter has been added with these amendments. Favorable consideration of the above amendments and following remarks is respectfully requested.

Claims 21, 22 and 24-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Engelson et al., U.S. Patent No. 5,972,019. In rejecting the claims, the Examiner asserts “Engelson et al. does not disclose a cage assembly including a proximal cage and a distal cage,” but “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Engelson et al. having a proximal and distal cage, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Office Action pp. 3-4, citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Applicants respectfully traverse this rejection.

Claims 21-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schmaltz et al., U.S. Patent No. 5,449,372, in view of Crittenden et al., U.S. Patent No. 4,719,924. In rejecting the claims, it is the Examiner’s position that although Schmaltz et al. does not disclose a cage assembly including a proximal cage and a distal cage, it “would have been obvious to one skilled in the art at the time the invention was made to have a proximal and distal cage, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.” Office Action pp. 5-6, citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Applicants respectfully traverse this rejection.

The Examiner’s reliance on *St. Regis Paper Co. v. Bemis Co.* in formulating the rejections is misplaced. Applicants assert the *St. Regis* case is inapposite to the case at hand. *St. Regis* dealt with a specialized bag including multiple layers. The court found that the “use of multiple layers to achieve the effect of many bags within one, has been known in the bag industry for many years.” *St. Regis*, 193 USPQ at 11. Thus, *St. Regis* dealt with what had previously existed in the prior art. The court further stated that the

arrangement of old elements in new combinations does not satisfy §103, unless the combination produces a synergistic effect. See *St. Regis*, 193 USPQ at 11.

In contrast to the patents at issue in *St. Regis*, in the present application, the claims define an invention not taught in the prior art which has notable benefits, providing a synergistic effect. Unlike the prior art relevant to the patents at issue in *St. Regis*, the applicable prior art apparently does not teach an embolism treatment device comprising a cage assembly including a proximal cage and a distal cage as claimed. The inclusion of a proximal cage and a distal cage may provide more than just a duplication of function. In fact, in some embodiments, the proximal cage and the distal cage may perform individualized functions. For example, as stated in the application, in some embodiments the proximal cage may provide rapid restoration of fluid flow through and/or remove an occlusion from a lumen, while the distal cage may capture dislodged embolic debris. See, for example, Specification, page 9, lines 10-21. Therefore, the inclusion of a proximal cage and a distal cage is not just a duplication of parts as suggested by the Examiner. As the currently claimed invention indeed includes limitations not found in the prior art and provides a synergistic effect, the holding of *St. Regis* is not controlling on the case at hand.

For at least the reasons stated above, the Examiner's reliance on *St. Regis* in formulating each of the rejections is misplaced. Therefore, Applicants assert all pending claims are currently patentable over the cited references and withdrawal of the rejections is respectfully requested.

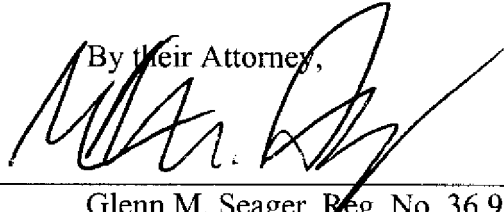
Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

GENE SAMSON ET AL.

By their Attorney,

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